

REMARKS/ARGUMENTSClaim Status

Claims 49, 52 and 55-58 remain pending in the application.

Claims 1-48, 50, 51, 53, 54 and 59 have been canceled in previous amendments.

Drawings

Applicant gratefully acknowledges the acceptance of the replacement drawing sheets filed November 13, 2006.

Nonstatutory obviousness-type double patenting

Applicant traverses this ground of rejection, and requests reconsideration. A notice of appeal is filed with this response.

Claims 49, 52, and 55-58 stand rejected on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over Claim 1 of Design Patent 489,462.

The nonstatutory double patenting rejection is based on a judicially created doctrine intended to prevent unjustified or improper extensions of a patents term. The nonstatutory obviousness-type double patenting rejection is applied where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the

basis of a previously issued utility or design patent, respectively. *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983).

Thus, while it is recognized in the Office Action that the conflicting claims are not identical, they are deemed as being not patentably distinct from each other in terms of the judicially created doctrine, as "each of the claims features are shown in the drawings which comprise the claim of the design patent."

In design-utility situations, however, a two-way obviousness determination is necessary for the rejection to be proper. In *re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Under the two-way test, the obviousness-type double patenting rejection is maintained only if the claims of the respective patents cross-read. As noted by the court, "[t]he doctrine prohibits claims in a second patent which define 'merely an obvious variation' of an invention claimed by the same inventor in an earlier patent."

The Federal Circuit further stated that it is in only in very rare cases that an obvious-type double patenting may be found between design and utility patents. The court cited *In re Thornton* (418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) for the principal that double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure".

In overruling the Board in *In re Dembiczak*, the Federal Circuit noted that the Board's suggestion that the design details were simply a matter of design choice evinced a misapprehension of the subject matter of design patents, and cited *Carman*, 724 F.2d at 939 n.13, 220 USPQ at 486 n.13, for the proposition that "[u]tility patents afford protection for the mechanical structure and function of an invention whereas design patent protection concerns the ornamental or aesthetic features of a design."

Looking at the application of the two way test from the view of the utility claim to the design, the Federal Circuit rejected the contention that the textual description found in the

claims of that utility patent application could render obvious the specific designs claimed in the design patents.

In the *In re Thorington* case, the design patent was titled "Continuous Non-Circular Cross-Section Lamp", and showed a fluorescent light that had a design with a helicoidal twist. 418 F.2d 529.

In the utility application that was under appeal the independent claims were similarly written as a general description of a fluorescent lamp, which incorporated helical paths around the envelope. Thus, in that situation, the independent claims essentially described the design shown for a fluorescent lamp with helicoidal twist as provided in the design patent. The court noted that while the claims in the utility could include helicoid designs that differed from the one shown in the design patent, these differences were not deemed significant.

In the present application, Claim 49 recites "[a] window comprising a building skylight adapted to be attached to the roof of a building, wherein the building skylight comprises: a main body being arched in the shape of a parabola or a V and having an apex, a base, a first length at substantially the apex and a second length at the base, wherein the first length is less than the second length; first and second end portions being disposed at first and second ends of the main body, respectively, each of the end portions having a top section and a bottom section, wherein the top sections define the first length and the bottom sections define the second length; and a corrugation disposed on the main body, wherein at least one of the end portions slopes toward the apex at an angle of between about 35 and about 65 degrees relative to the base."

The D489,462 patent has one claim, to the ornamental for the skylight shown and described in Figures 1 through 5. The design patent figures are essentially reproduced in Figures 1-5 of the present application.

However, in Figures 6 through 22 of the present application, numerous features and aspects of the invention are provided which help to demonstrate how the scope of Claim

49 is significantly greater than the ornamental design features of Claim 1 of the design patent. The differences include the very shape of the window, and in particular, the shape of the main body, which can be any of a variety of arched or V-shaped configurations.

There is also a great deal of variability in the overall dimensions of the invention of Claim 49 of the utility application, from the relative lengths of the apex and base, it being only limited to the first length assigned to the apex being somewhat less than the second length assigned to the base.

Further differences that could take infringing embodiments of the utility application far away from the ornamentation of the design patent claim include the angles of the first and second end portions at each end of the main body, as well as the number, shape and height of the corrugations disposed on the main body.

In light of the above remarks, Applicant believes that the application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant encloses a check for fees are required by this response and the notice of appeal, but if Applicant is mistaken, any required fees may be charged to deposit account 50-1577.

If the Examiner has any questions regarding this communication, he is invited to contact the undersigned at (916) 930-2585.

Respectfully submitted,

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